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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,995	02/09/2001	Ken Kutaragi	SCEI 18.302	5881

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KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK,, NY 10022-2585

EXAMINER	
ALVAREZ, RAQUEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/780,995	KUTARAGI ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to communication filed on 9/7/2005.

2. Claims 1-13 are presented for examination.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (5,835,087 hereinafter Herz).

With respect to claims 1, 4-6, 8, 11-13 Herz teaches an in contents-advertising method wherein advertisement information provided beforehand is included in digital contents activated by a user terminal (Summary). Determining that the digital contents have been activated by the user (col. 55, lines 45-54); transferring an identifier of the digital contents and an identifier of the user to an advertising information server when the digital contents have been activated by the user (col. 55, lines 45 to col. 56, lines 1-14); selecting and retrieving advertising information by the advertising information server based on the digital contents identifier and the user identifier and transferring the retrieved advertising information to the user terminal (col. 60, lines 11-20); inserting the retrieved advertising information in the digital contents such that the advertising information is automatically selected and retrieved from the advertising server, transferred to the user terminal and inserted in the digital contents when the digital

contents are activated in the user terminal by the user (col. 55, lines 45 to col. 56 lines 1-14; col. 60, lines 11-20 and col. 61, lines 4-26).

With respect to the digital contents being activated in a game program, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The digital contents would be performed the same regardless if is activated on a game program or not. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381,1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to activate the digital content in a game program because such data does not functionally alter the method or system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

With respect to claims 2-3, Herz further teaches providing the advertising information by the advertising sever to the contents provider for insertion in the digital contents (Figure 1).

Claims 7 and 9, further recite advertising fees based on said recording results. Official notice is taken that it is old and well known to charge based on recording/product quality. For example, a low/inferior quality recording or product gets a lower fee that a high quality product or recording in order to compensate for good

performance. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included advertising fees based on said recording results in order to obtain the above mentioned advantages.

Claim 10 further recites the advertisers providing the times of the advertisement insertion and providing said ads based on said advertisements information specified from said advertiser. Official notice is taken that is old and well known for advertisers to select the times slots and structure in which they want the advertisements to be displayed to the customers. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the advertisers providing the time of the advertisements insertion because such a modification would allow the advertisers to target the proper audience based on the time period selected.

Response to Arguments

5. Applicant argues that Herz does not disclose a system that inserts retrieved advertising information into digital content activated by a user, where the retrieved advertising information is selected based on the activated digital content. The Examiner respectfully disagree with Applicant. In Herz, the system inserts advertisements (col. 55, lines 45-54 and 60, lines 11-20) based on the digital content activated by a user (i.e. the user activates the digital content by choosing to read, access or provide feedback to the digital article)(col. 55, lines 45 to col. 56, lines 1-14).

6. With respect to the digital content being activated in a game program. The

Examiner wants to point out that the content being activated in a game program is nonfunctional descriptive material and is not functionally involved in the steps recited. See rejection above for dull analysis of the nonfunctional descriptive material.

Point of contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
11/10/2005